

## REMARKS

This responds to the Office Action mailed on April 18, 2006.

Claim 31 was amended to correct a typographical error. Claims 1-31 are now pending in this application.

### *§102 Rejection of the Claims*

Claims 1-31 were rejected under 35 U.S.C. § 102(e) for anticipation by Hunter et al. (U.S. Patent No. 6,298,327). This rejection is respectfully traversed. Hunter et al., lacks at least one element of each claim, so it cannot serve to anticipate the claims.

In the Final Office Action, a Response to Arguments is presented on page 2 that indicates that “HUNTER teaches the searching capability as provided by a database via a network by potential customers and independent customers (Column, 4, Lines 21-32).” Applicant respectfully disagrees. Claim 1 recites “providing search facilities via the network for potential customers **not related to the innovators** to find inventions.” emphasis added. Hunter et al., recites that “three types of users are served by the proposed software product: inventors, technology managers, and patent professionals.” Col. 2, lines 54-56. It also indicates that “The present invention is expert support system software that enables inventors to adequately disclose (communicate) the characteristics of their inventions to **their** technology manager and research sponsor, as well as to **their** patent professional (i.e., patent attorney or patent agent).” Col. 2, lines 43-47. Emphasis added. Thus, Hunter et al., clearly describes a system for users that are related to the innovators, which is different than the claimed customers not related to the innovators. There is no teaching or suggestion in Hunter et al., that their system could be used by others to search for innovations to potentially fund as described in dependent claim 4.

The Office Action provides Claim Rejections starting on page 3. These rejections are similar to those made in an earlier Office Action, and the response thereto is included below in expanded form to point out further distinctions.

Hunter et al., describes a system for authoring invention disclosures and for evaluating the probably patentability and marketability of a disclosed invention. However, it does so in a captive environment. In other words, it allows people other than the inventor, but associated with the inventor, such as technology managers or sponsors to evaluate disclosures that have been authored. The presently claimed invention is directed externally. In other words, it is directed at providing access to people who are not directly associated with the inventor to search for innovations that have been described, and view the innovations as well as evaluations of the innovations. The claims reflect different versions of this that clearly distinguish the teachings of Hunter et al.

The Office Action indicates that Hunter et al. describes “a database for storing the descriptions of inventions and evaluations by class and providing search facilities via the network for potential customers not related to the innovators to find inventions {See Fig. 2, Element 32 and Column 24, Lines 60-62, wherein this reads over “abstract subclass Records Databases 31 and abstract subclass Text Files Databases 33 inherent behavior (member functions or methods) from super class Databases 32”}”.

The cited portions of Hunter et al., merely describe the structure of a database. The claim language recited specifically includes “search facilities via the network for potential customers not related to the innovators to find inventions.” The cited portions do not describe this feature. Further, Hunter et al., in Col. 2, lines 43-50 describes that the system “enables inventors to adequately disclose (communicate) the characteristics of their inventions to their technology manager and research sponsor...” Unrelated potential customers are not included, and further, there is no specific teaching of search facilities via a network for potential customers. Another portion of Hunter et al., describes the use of a non-enabling disclosure for use by technology managers to attract commercial interest at Col. 8, lines 31-34, but again, no teaching that potential customers can search via a network.

Since at least one element is lacking in the Hunter et al., a *prima facie* case of anticipation has not been established, and the rejection should be withdrawn.

Dependent claim 3 describes a facilitator for controlling interaction between innovators and potential customers. Hunter et al., does not describe potential customers, and thus cannot have a facilitator as claimed.

Dependent claim 4 also recites a facilitator that provides for potential customers to fund intellectual property protection for inventors. The Final Office Action indicates that Hunter et al., describes this feature at Col. 2, lines 47-50, wherein one of the groups of people related to the inventor, a technology manager or research sponsor may decide whether to invest in protecting the invention. Again, this is a person or group that is related to the inventor, and not a potential customer that is not related to the innovators.

Dependent claim 6 recites that the facilitator controls access to a selected group of potential customers. The Final Office Action indicates that this is shown in Hunter at Col. 2, lines 43-47. This language specifically refers to groups that are related to the inventor, not outside customers, much less a selected group of potential customers.

Dependent claim 7 refers to an owner of the system to be provided a royalty on the inventions. The Final Office Action indicates this is provided in Hunter at Col. 2, lines 50-55. However, a reading of the language: “if protection is sought, it must be complete enough for the patent professional to be able to determine whether patent protection is appropriate and, if so, to be used as a basis for preparation and prosecution of a patent application” says nothing about a royalty, much less a royalty to the owner of the system. Since this element is lacking, a proper *prima facie* case of anticipation has not been established and the rejection should be withdrawn.

Dependent claim 8 includes a translation module that translates descriptions of inventions. The Final Office Action indicates that Hunter et al., describes this at Col. 3, lines 14-17: “because domain knowledge can be complex and its language ‘foreign’, exchanges of information are typically clarified by guidance, explanations, and examples”. In the proper context, the language quoted in Hunter et al., relates to explaining language in an expert’s domain using explanations and examples, not to the translation of an invention description. Thus, Hunter et al., does not anticipate claim 8, and the rejection should be withdrawn.

Independent claim 11 recites making the database selectively viewable to potential customers of the invention who are not related to the innovators. Hunter et al., does not describe

making the database available to unrelated parties. The Office Action cites Col. 18, lines 30-31 as describing this feature. Such cited text refers to expert objects, not to potential customers. It is not seen how such cited text describes the claim language.

Claims dependent to claim 11 may be similar to the above dependent claims, and others offer further distinctions. Claim 14 provides for anonymity of at least one of the innovators and potential customers. The Final Office Action indicates this element is met at Col. 17, lines 62-63, which reads: “a client class sends a message to a server class requesting assistance in fulfilling a client responsibility”. Applicant fails to see how that language hints at anonymity as claimed. A proper *prima facie* case of anticipation has not been established and the rejection should be withdrawn.

Independent claim 22 recites making the invention input and recommendation available to selective independent customers via network connection. The Office Action cites Col. 17, lines 8-10 as describing this element. However, the cited language of Hunter et al., simply describes a portion of an invention disclosure that is drafted through use of the system, wherein the disclosure identifies problems involved with the prior art. It is not seen how this teaching corresponds to the cited element of making information available to selective independent customers via network connection.

Independent claims 29 and 31 distinguish Hunter et al., for the same reasons as claim 22, in that it also recites: making “the invention input and recommendation available to selective independent customers via network connection.”

Each of the dependent claims depend from a claim that is believed allowable. Applicant reserves the right to separately argue additional distinctions at a later date, and hereby traverses any official notice or inherency arguments that may have been made.

**AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE**

Serial Number: 10/008,434

Filing Date: November 13, 2001

Title: A NOVEL METHOD, SYSTEM, AND PROCESS FORACQUIRING, EVALUATING, PATENTING, AND MARKETING INNOVATION

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Dkt: 1450.001US1

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6th day of September, 2006.

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